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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,661	12/27/2004	Donald L. Rymer	AD6871USPCT	7413

7590 05/28/2008  
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4417 Lancaster Pike  
Wilmington, DE 19898

EXAMINER
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BERNSHTEYN, MICHAEL

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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05/28/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/519,661	<b>Applicant(s)</b> RYMER ET AL.	
	<b>Examiner</b> MICHAEL M. BERNSHTEYN	<b>Art Unit</b> 1796	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 April 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 and 13-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6 and 8-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-6 and 8-18 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This Office Action follows a response filed on April 25, 2008. Claims 6 and 8 have been amended; claim 7 has been cancelled without prejudice; no claims have been added.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 25, 2008 has been entered.
3. Claims 6 and 8-12 are active.

### ***Claim Rejections - 35 USC § 103***

4. The text of this section of Title 35 U.S.C. not included in this action can be found in a prior Office Action.
5. Claims 6, 8 and 10-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable as obvious over Klock et al. (EP 0 402 213 A1) in view of Rombach et al. (U. S. Patent 3,153,009), for the rationale recited in paragraph 7 of Office Action dated on November 28, 2006.
6. Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Klock et al. in view of Rombach et al. as applied to claims 6-8 and 10-11 above and further in

view of Aurenty et al. (U. S. Patent 6,472,054), for the rationale recited in paragraph 8 of Office Action dated on November 28, 2006.

7. Claim 12 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Klock et al. in view of Rombach et al. as applied to claims 6-8 and 10-11 above and further in view of Kroggel et al. (U. S. Patent 5,559,175), for the rationale recited in paragraph 9 of Office Action dated on November 28, 2006.

### ***Response to Arguments***

8. Applicant's arguments filed on April 25, 2008 have been fully considered but they are not persuasive.

9. Regarding to the Applicants arguments that the surfactants described by Klock are present in an amount of greater than 0.3 wt% or greater than 0.4 wt% based upon the dry weight of PVA, and Rombach permits only 0.04 to 0.2 wt% of surfactant, based on the weight of the polyvinyl alcohol; therefore Klock and Rombach teach away from each other (pages 6-7 the bridging paragraph, page 7, 2<sup>nd</sup> and 3<sup>rd</sup> paragraphs), it is noted that the first reference by Klock, which is the closest prior art, clearly discloses the amount of surfactants within the claimed range (abstract).

It is worth to mention that the second reference of Rombach was used only to cover the deficiencies of Klock regarding the temperature of stirring reaction mixture (RM) in the range of from 80<sup>o</sup>C to about 100<sup>o</sup>C in step (b), not the amount of surfactant.

10. In response to the arguments that these two references teach away from each other (page 7, 4<sup>th</sup> paragraph), it is noted that "the prior art's mere disclosure of more

than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed....” ***In re Fulton***, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). See also MPEP §2123.

11. In response to applicant's argument that there is no suggestion to combine the references (pages 6-7 the bridging paragraph, page 8, 2<sup>nd</sup> paragraph), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references are analogous art because they are from the same field of endeavor concerning new processes for producing polyvinyl butyral resin.

12. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL M. BERNSHTEYN whose telephone number is (571)272-2411. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael M. Bernshteyn/  
Examiner, Art Unit 1796

/M. M. B./  
Examiner, Art Unit 1796

/Randy Gulakowski/  
Supervisory Patent Examiner, Art Unit 1796